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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,325	12/08/2003	Jerome Skuba	Skuba-P1-03	2418

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EXAMINER

PALO, FRANCIS T

ART UNIT PAPER NUMBER

3644

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,325

Applicant(s)

SKUBA, JEROME

Examiner

Francis T. Palo

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>third non-final rejection</u> . |

DETAILED ACTION

Claim Objections

Claim-1 is objected to because of the following informalities:

In the third-to-last line of the claim; "at least" should be changed to --at at least--, or some functional equivalent. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a),
as being unpatentable over Tunica (US 268,441) 1882,
in view of Milstein (US 4,941,282) 1990.

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Regarding **claim-1**:

The examiner submits that the steps of the instant method claim(s) are common knowledge to homeowners and landscape architects alike and furthermore are a matter of common sense; for example, the method claim steps would be readily apparent from an advertisement of a vendor at a horticultural show, wherein an ornamental plant design would be presented to the public by forming, implementing, transporting and installing specimens (pieces) as claimed.

In the alternative; the applicant has submitted in the response filed 11/28/05, that the previous two non-final office actions fail to teach 'a preexisting design' as claimed; that deficiency is remedied by Tunica '441.

Tunica teaches borders for parks and gardens and depicts in figure-1 a design readable on a preexisting design, as such designs in parks are arguably preexisting; Tunica is therefore relied upon for the teaching of a preexisting design and the implementing of the design as claimed, would be inherent to the creation of the ornamental beds depicted.

Furthermore, the formation of a piece corresponding to a portion of the design as claimed, would also be inherent to the formation of the design, and it is well-known common practice; that is, forming a piece corresponding to a portion of the design by growing the piece at (at) least one grower location, transporting the piece to a user's site and installing the piece, as claimed.

Art Unit: 3644

Again in the alternative, Milstein '282 teaches wildflower sod mats which may be cut (as for instance, for use in the Tunica '441 design), and further recites in the abstract, "the consumer is provided with an established sod mat".

In conclusion, Tunica '441 in view of Milstein '282 teaches the obviousness of the instant method; specifically, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified the park and garden design of Tunica to include the ornamental sod mats of Milstein as claimed, for the known advantages of that modification, and further, the method steps of the instant claim would be readily apparent during the use and maintenance of the Tunica park and garden ornamental design, as claimed.

Regarding independent claim-2:

The discussion above regarding claim-1 is relied upon as encompassing the limitations of the instant claim-2. that is, Milstein teaches the use of wildflower sod mats to the consumer (abstract).

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Regarding claims 3-5:

The discussion above regarding claim-2 is relied upon.

Milstein teaches, "that while the present invention is suitable for the propagation of wildflowers, the propagation technique disclosed herein is equally applicable to domesticated perennial and annual plants" (column-4, lines 3-6); that teaching is readable on more than one of the members as claimed.

Regarding claims 6-15:

The discussion above regarding claim-3 is relied upon.

In addition to the previous discussion above, Milstein teaches fifteen (15) species in Table –A, and the teaching of domesticated perennial and annual plants would encompass the selections of the instant claims 6-15, as claimed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

King Ranch Wildflower Carpet (The Worry-Free Approach To Landscaping With Wildflowers) advertisement depicts a landscaped bed in the background of the front page and perennial flower mats; the second attached page is the reverse of the one page advertisement. Note the statement at the bottom of the page.

Ripley '834 (previously cited) encompasses the method of the instant invention.

Molnar '290 (previously cited) encompasses the method of the instant invention.

Smith '708 (previously cited) encompasses the method of the instant invention.

[MISAN] JP 10313690A teaches the instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis T. Palo whose telephone number is 571-272-6907. The examiner can normally be reached on M-Tu.,Th.-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Francis T. Palo
Francis T. Palo
Primary Examiner
Art Unit 3644